



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------------|------------------|
| 09/863,735 | 05/23/2001 | Naishin Seki | JA9-2000-0085 (8728-516) | 9928 |
| 46069 | 7590 | 01/19/2006 | EXAMINER O'CONNOR, GERALD J | |
| F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797 | | | ART UNIT 3627 | PAPER NUMBER |

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/863,735 | Applicant(s) Seki et al. | |
| | Examiner O'Connor | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 27, 2005 and November 14, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 23, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2005 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on May 27, 2005 in reply to the previous Office action on the merits, mailed February 24, 2005, and to the election filed by applicant on November 14, 2005 in reply to the Office action setting forth a requirement for restriction, mailed August 11, 2005.

3. The amendment of claims 1, 5, 10, 11, 13, 14, and 16, cancellation of claims 4 and 9, and addition of claims 17-19 by applicant, in the reply filed May 27, 2005, are hereby acknowledged.

4. Applicant is advised that the currently pending claims are claims 1-3, 5-8, and 10-19, not claims 1-19 as stated by applicant in the reply filed November 14, 2005. Note that claims 4 and 9 were cancelled by applicant as acknowledged above and in the previous Office action.

Election/Restriction

5. Applicant's election with traverse of Invention I (Claims 1-3 and 5-8) in the reply filed November 14, 2005 is hereby acknowledged. The traversal is on the ground(s): that (1) the previous examiner was able to examine all the claims without making a restriction requirement; that (2) three of the seven inventions, though classified differently, are classified in the same basic class, class 705; that (3) search and examination of all inventions would be of "no serious burden to the examiner;" and, that (4) applicant has already received an action on the merits in the application and 37 CFR 1.142 states that such requirements will normally be made before any action on the merits.

6. Applicant's arguments have been fully considered but are not found persuasive.

7. Regarding the argument that the previous examiner was able to examine all the claims without making a restriction requirement, the argument is irrelevant, since another examiner choosing to examine additional inventions for free, on his or her own time, is entirely within the discretion of the other examiner. So doing by another examiner in no way encumbers the current examiner with the same burden. Moreover, applicant's argument is, at best, disingenuous, since newly added claims 17-19, Inventions VI and VII, have not yet been examined, nor have any of Inventions I-V, since applicant amended all previous inventions, such that, in fact, *none* of the *current* claims drawn to *any* of the inventions in the application have yet received any action on the merits. None.

8. Regarding the argument that three of the seven inventions, though classified differently, are classified in the same basic class, classifications comprise two components, a “class” and a “subclass,” not merely a “class.” Therefore, the classifications for inventions are different even if the basic class is the same. Since applicant feels that searching additional classifications is of no burden, much less any serious burden, perhaps applicant will read through the additional 4,309 documents that applicant argues the examiner should read (i.e., just the ones in the other subclasses of the same basic class as the elected invention).

9. Regarding the argument that search and examination of all inventions would be of “no serious burden to the examiner,” MPEP § 803 states, in part, under “Guidelines”:

A serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

10. As the examiner has indeed made such a *prima facie* showing of serious burden, based upon separate classification, as set forth in the requirement for restriction (Office action mailed August 11, 2005), and as applicant has offered no “showing or evidence” in rebuttal to that conclusion, simply an opinion stating a contrary position, applicant’s arguments have been dismissed as merely spurious, amounting to simply a general allegation that a serious burden would not be imposed, without specifically pointing out how the language of the claims fails to comport with the explanation of separate classification provided by the examiner.

11. Regarding the argument that applicant has already received an action on the merits in the application and 37 CFR 1.142 states that such requirements “will normally be made before any action on the merits,” applicant again resorts to a disingenuous argument, since applicant misquotes the CFR by including a period at the end, when, in fact the quoted snippet is but merely the beginning of the sentence, which sentence actually states, with emphasis added to the portion conveniently omitted by applicant, “Such requirement will normally be made before any action on the merits; *however, it may be made at any time before final action.*” Additionally, as pointed out above, applicant has received no action on the merits for any of the instant claims, since all of the claims have been amended or added since the last action on the merits in the instant application.

12. The restriction requirement is still deemed proper and is therefore made FINAL.

13. Claims 10-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction requirement in the reply filed November 14, 2005.

14. Regarding the questionable/tenuous nature of applicant’s arguments, the examiner notes that, compared to other patent attorneys/agents, applicant appears to be unfamiliar with patent prosecution. Whereas a lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed, applicant is advised to secure the services of a

knowledgeable, registered patent attorney/agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, DC 20402, and is also currently available online at:

<http://www.uspto.gov/web/offices/dcom/olia/oed/roster/region/index.html>.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

16. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al. (US 2001/0014868).

Herz et al. shows, in Figure 1, a system for the automatic determination of customized prices and promotions. The primary functions of the system for the automatic determination of customized prices and promotions (price setting means) 100 are (1) to identify offers that are appropriate for each shopper, (2) to help the shopper become informed about these available offers (product information provision means), and (3) to facilitate any or all of the necessary transactions, such as electronic ordering or payment (retail means), if the shopper decides to accept an offer. Demographic and/or consumer information about the shopper or similar shoppers is obtained from other databases, e.g., from a consumer database purchased from a credit-card company, or a database that correlates the response to telemarketing campaigns with demographic variables. The main computer selects offers from the offer database that are likely to result in profitable sales (price trend means, basic rule of supply and demand). "Retail sales state" and means for managing it, as vaguely defined in applicant's specification, is shown throughout the reference in demand curves and more specifically on page 32, paragraph 301, which states, "Time series methods are also useful for detecting trends; one could do a linear regression on sales for a certain product over time, determining the overall direction of a product's sales. This information could be used to adjust offer-generating strategies, as it would indicate a waxing or waning of a customer's overall interest in a given product."

Response to Arguments

17. Applicant's arguments filed May 27, 2005 have been fully considered but they are not persuasive.

18. Regarding the argument that Herz et al. do not disclose "product information provision means," Herz et al. indeed disclose product information provision means. Otherwise, the offers could not be made to the shoppers. Note that the arrangement of Herz et al. comprises each shopper interacting with the automatic determination of customized prices system, which interaction necessarily includes requesting and receiving of information. The additional claim recitations, drawn to extensively recited functional language which the claimed apparatus is envisaged to perform, the recitations have been deemed merely intended usage of the invention, hence, afforded little patentable weight. The actual claimed structural elements recited by the arguments include merely "product information provision means," followed by an extensive description of intended usage that the recited element of "product information provision means" is envisaged to perform, for example, "for, upon the receipt of an information request regarding said product from a user via said communication network, furnishing the user with the information concerning said product and said price of said product."

The manner of operating a device does not differentiate apparatus claims from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the *structural* limitations of the claim. *Ex parte Masham*, 2

USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material.” The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

For further edification regarding lack of relevance, hence, patentable weight, of functional language in apparatus claims, refer to MPEP §2114.

19. The arguments regarding the non-elected and/or cancelled claims have been considered, but have been rendered moot by applicant’s amendment consequent election.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to the disclosure.

21. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

22. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor,
Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

January 11, 2006

A handwritten signature in black ink, followed by the date "1/11/06" written in a similar style.

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627